

REMARKS/ARGUMENT

Claim 1 has been amended by incorporating the subject matter of claims 3 and 4 into it.

Claims 3, 4, 19 and 22 have been canceled.

New claims 23-26 have been added, support for which exists throughout the present application including page 5, lines 33-37, and page 6, last paragraph.

Claims 1, 2 and 5-18, 20, 21 and 23-26 are currently pending.

The Office Action rejected claims 3 and 22 under 35 U.S.C. § 112, second paragraph, as being indefinite. The Office Action also objected to claims 6, 18 and 19. Applicants respectfully submit that the above claim amendments and cancellations have rendered these rejections/objections moot, and that the rejections/objections should be reconsidered and withdrawn.

The Office Action also rejected claim 22 under 35 U.S.C. § 101. Applicants respectfully submit that this rejection has been rendered moot and should be withdrawn.

The Office Action further rejected claims 1 and 3 under 35 U.S.C. § 102 as anticipated by, or in the alternative, under 35 U.S.C. § 103 as obvious over U.S. patent 4,961,979 (“Iida”), and claims 1-14 and 16-22 under 35 U.S.C. § 103 as obvious over Iida in view of (1) U.S. patent 4,107,019 (“Takao”)(claims 1-3), (2) U.S. patent 5,483,067 (“Fujii”)(claim 4), (3) U.S. patent 5,981,092 (“Arai”) and Takao (claims 5 and 6), (4) U.S. patent 5,522,976 (“Campet”) and Takao/Arai (claims 7-14), (5) U.S. patent 5,831,760 (“Hashimoto”) and Takao/Arai (claims 16-21), (6) IBM technical disclosure and Takao/Arai

(claim 20), (7) U.S. patent 5,905,590 (“Van Der Sluis”) and Takao/Arai (claim 21), and (8) U.S. patent 4,832,469 (“Ito”) and Iida (claim 22). In view of the following comments, Applicants respectfully request reconsideration and withdrawal of these rejections.

In view of the above amendments in which Applicants incorporated the subject matter of claims 3 and 4 into claim 1, Applicants respectfully submit that all of the pending rejections have been rendered moot. None of the pending rejections relate to claims having scope similar to that of the currently pending claims.

Furthermore, Applicants respectfully submit that the combination of Iida and Fujii would not constitute a *prima facie* case of obviousness for the currently claimed subject matter. Fujii is the only applied art asserted to demonstrate the required resistivity. However, this reference is not properly combinable with Iida.

Iida relates to recording media in which NiO_x is irradiated to “become close to NiO” (col. 3, lines 15-16) to effect information writing. Iida’s NiO layer must be “low in its heat conductivity.” (Col. 3, lines 48-51). Heat conductivity tracks electrical conductivity (electrons transfer heat and energy). Thus, Iida’s NiO layer which is low in its heat conductivity should also be low in electrical conductivity. If a layer is low in electrical conductivity, it follows that it is high in electrical resistivity. Accordingly, Iida teaches that its NiO layers must be high in electrical resistivity.

Given this teaching, no motivation would have existed to lower the electrical resistivity of Iida’s NiO layers. In fact, such a lowering would have been directly contrary to Iida’s teachings -- in other words, Iida teaches away from such a modification. Under these circumstances, the combination of Iida and Fujii would be improper.

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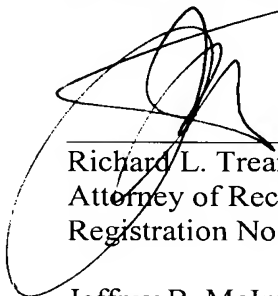
In view of the above, Applicants respectfully request reconsideration and withdrawal of the pending rejections under 35 U.S.C. §§ 102 and 103.

Finally, the Office Action rejected claims 17-22 under the judicially created doctrine of obviousness type double patenting over claims 1-35 of U.S. patent 6,277,523. Applicants respectfully request reconsideration and withdrawal of this rejection given that the claims in the '523 patent do not include or suggest all of the limitations of the currently pending claims.

Applicants believe that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

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